

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the application of: Solar Cell Module)	Atty Dkt. TOR.011.0001.NP
)	
Inventor: Sadaji Tsuge)	Confirmation No.: 1063
)	
Serial No.: 09/788,339)	Examiner: Barton, Jeffrey Thomas
)	
Filing or 371(c) Date: 2/21/2001)	Art Unit: 1753

Honorable Commissioner for Patents
Alexandria, Virginia 22313-1450

REPLY BRIEF

This is a reply to the new points of argument in the Examiner's Answer dated September 24, 2008, pursuant to 37 CFR § 41.41.

ARGUMENT

The 35 U.S.C. § 103 Rejections Are Improper and Should Be Reversed

(1) JP 11-307791 in view of Yamagishi et al., Brandhorst, Jr., Spitzer, Mitsui and the instant disclosure;

(2) Brandhorst, Jr. in view of Mimura et al., Mitsui and the instant disclosure;

(3) Mimura in view of Brandhorst, Jr., Mitsui and the instant disclosure are Improper

The rejection of claims 16, 18-20, 23 and 24 as being unpatentable over JP 11-307791 ("JP '791") in view of Yamagishi et al., Brandhorst, Jr., Spitzer, Mitsui, and the instant disclosure, of claims 16, 18-20 and 22 as being unpatentable over Brandhorst, Jr. in view of Mimura et al., Mitsui and the instant disclosure, of claims 16, 18-20 and 22 as being unpatentable over Mimura in view of Brandhorst, Jr., Mitsui and the instant disclosure, are improper and should be reversed.

As in the final rejection, the Examiner's Answer selectively picks and chooses various isolated and individual elements from various disparate prior art references in a hindsight attempt to recreate the claimed invention. Of particular note is the need to rebuild the entire structure of the base JP '791 reference in an attempt to recreate the invention set forth in claim 16. For example, at page 7 of the Answer, the Examiner acknowledges that in order to even approach the limitations of claim 16, the Examiner must "take the solar cell in JP '791's Figure 2, flip it over it over (*sic*), and then insert into it JP '791's Figure 1." According to the Answer, this would have been obvious even though, as acknowledged in the Answer, "JP '791 does not explicitly teach that the resin adhering the light incidence side light transmitting member at the light incidence side of the solar cell element contains sodium ion, nor does the reference explicitly disclose that a one conductive type crystalline semiconductor substrate is disposed between the semiconductor junction and the resin containing the sodium ion." Answer at 4. Thus, in order to support the proposed modification of JP '791, the Answer must first create a problem in the '791 device that does not exist, namely the presence of a sodium ion in the resin for adhering the incident light transmitting member at the light incidence side of the solar cell element.

The Answer further improperly attempts to equate the lack of an explicit structural requirement in the JP '791 reference with a teaching or suggestion to support the proposed modifications of the JP '791 reference. See Answer at 6 ("JP '791 does not require said one principal plane . . . to be the front face;" "JP '791 does not require layers 12 and 13 to be at the front surface and layers 16 and 17 to be at the rear face."). Thus, merely from the observation that JP '791 allegedly "is not limited" to the disclosed structure and allegedly "does not require" the disclosed structure, the Answer concludes that the proposed complete reconfiguration and restructuring of the disclosed JP '791 structure would have been obvious. Alleged lack of an explicit statement that the disclosed structure is "required," does not equate to a reason, teaching, or suggestion from which one of ordinary skill in the art would have been motivated to make the purported modifications suggested by the Answer.

Remarkably, the Answer at page 16 does not deny that the conclusions of obviousness rest on "a reconstruction based on hindsight reasoning." The Answer

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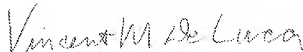
attempts to improperly shift the burden to Appellants to provide “specific arguments against the motivations that are provided for the modifications to the primary reference.” The burden is on the Examiner in the first instance to establish the obviousness of the proposed modifications. Here, the Answer has simply concluded that it would have been obvious to do what Appellants have done, which, according to the Answer, requires disassembly of the prior art devices as disclosed, and complete rearrangement of parts and reconstruction so as to meet the limitations of the claimed invention. No motivation has been provided for such reconstruction, other than unsupported assertions and conclusions.

Finally, the Answer “disagrees” that Appellants’ specification has been improperly relied upon as an admission of prior art, citing the mention of a moisture proof test (JIS C8917). However, the specification clearly states that it is the invention that was made under the conditions set forth therein, wherein the moisture proof test was conducted by the inventors to determine the cause of degradation of power generation performance. The specification does not state, as alleged in the Answer, that the moisture proof test “results in sodium ion deposition into the sealing resin from the front glass.” To the contrary, the specification clearly sets forth that it is the present inventors who discovered that sodium ions in the resin film cause the power degradation.

Conclusion

In view of the foregoing, and the arguments set forth in the main Appeal Brief, claims 16 and 18-20 and 22-24 are submitted to define patentable subject matter over the prior art of record, whether considered individually or in combination. The Honorable Board is requested to reverse all grounds of rejection as being improperly based and legally unfounded, and to direct passage of this application to allowance.

Respectfully submitted,



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